

PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

KAREL VAN DEN BERG

Serial No.: 09/884,829

Filed: June 19, 2001

Group Art Unit: 3679

Examiner: Victor MacArthur

For: AN IMPLEMENT FOR DEMARCATING AN AREA AS WELL AS A
VEHICLE SUITABLE FOR BEING USED IN SAID TREATMENT

RESPONSE

To the Commissioner of
Patents and Trademarks
Washington, D.C. 20231

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Sir:

This is in response to the Official Action of June 19, 2002 which is a restriction requirement.

In the restriction requirement, it was acknowledged that Claims 1, 28, 29, 39, 41-44, 47 and 48 were generic claims. Accordingly, such claims should be considered as included, by reference, in the listed elected claims to be set forth hereinafter in this Response to the restriction requirement.

The groups set forth in the Official Action from which an election must be made in this Response are as follows:

Group I, Species 1, directed to the embodiment of the demarcating implement as shown in Figures 1-3; and

Group II, Species 2, the embodiment of the demarcating implement as shown in Figures 4-7.

It is further stated that Applicant is required under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. As indicated above, the generic claims were considered to be Claims 1, 28, 29, 39, 41-44, 47 and 48.

To be completely responsive, Applicant provisionally elects the claims covered by Group I or Species 1 as set forth above. The restriction requirement is, however, respectfully traversed.

Initially, it is to be observed that no specific reason for the restriction requirement was set forth in the Official Action other than to state that it is under 35 U.S.C. §121. Section 121 provides that if two or more independent and distinct inventions are claimed in one Application, the Commissioner may require the Application to be restricted to one of the inventions. There is nothing in Section 121, as such, to authorize a restriction requirement on the grounds that different species of the invention may exist. The issue is whether or not the claims are "independent and distinct" although "and," has been construed, whether or not legally correct, as "or" it is submitted that the inventive concepts disclosed in the instant Application are neither independent nor distinct. They all involve the demarcation of a pasture or the like in which animals are confined and wherein the area which is confined can be readily adjusted by the apparatus of the invention. An example for independent and distinct inventions under 35 U.S.C. §121, which is relatively common in the literature, is an automobile engine on one hand and an automobile horn on the other. Clearly manufactures of this type are independent and distinct wherein a restriction requirement is appropriate. But such example contrasts markedly with the groups or species set forth in the Official Action of June 19, 2002.

In addition to the foregoing, it is submitted that there is a serious question whether or not the groups are directed to different "species" as such. The term "species" should not be considered necessarily synonymous with "embodiments." A "species" is a classification below a genus or subgenus but above a variety. In other words a species may comprise a number of objects or groups which are a single species by virtue of their common attributes. For example, dogs, that is a domesticated carnivorous mammal (*canis familiaris*), are considered to fall within a single species which is related to other species such as foxes or wolves, but comprises numerous variations (breeds) such as german sheppards, bulldogs, scottish terriers, great danes, poodles, St. bernards, collies, dachshunds, and so forth, all of which can be identified by different attributes, but which, nevertheless, are all part of the same species.

To be completely responsive, Applicant was advised in the Official Action that the election requirement must include a list of all claims readable on the elected group (or "species"). Accordingly, in addition to the claims listed in the Official Action as generic, the following claims are considered as readable on the Group I claims: 30, 32-37, 46 and 51-54. Of these claims, Claims 34, 37, 51, 52 and 54 are considered to be linking claims.

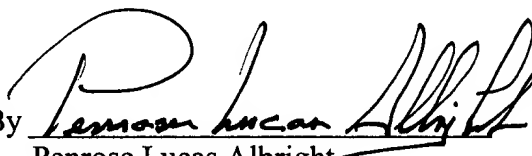
It should be kept in mind that claims, as such, are not species, as such, or even variations of the same invention, as such. All claims in a patent are considered to be patentably distinct from all other claims. If this were not the case, claims which were not patentably distinct would be objectionable on the basis of double patenting. Claims in the same patent may be patentably distinct one from the other in the sense that 35 U.S.C. §103 without the claims being invalidated for that reason. Indeed this is one of the objectives which a responsible registered patent attorney should and usually does have in mind when drafting claims. Accordingly, the paragraph in the Official Action bridging pages 2 and 3 is not understood or, if understood, is inconsistent

not only with patent law and practice in this country, but also with applicable statutory provisions and regulations for the implementation thereof. To suggest that inventions which fall within the same species must be considered obvious variants of each other is inconsistent with 35 U.S.C. §103 wherein obviousness and non-obviousness are the criteria for invention. Indeed, if the statement is true, this means that numerous, perhaps most, plant patents are necessarily invalid because most plant patents are directed to variations or varieties of the same species such as different species of roses. Yet 35 U.S.C. §161 which relates to patents for plants provides that the provisions of this title relating to patents for inventions shall apply to patents for plants except as otherwise provided.

In view of the foregoing, it is submitted that the restriction requirement which has been imposed in the instant Application should be withdrawn and examination of the Application should proceed on all claims as presently submitted.

Respectfully submitted,

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